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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/855,971   | 05/15/2001  | Takao Omachi         | NEC N01268          | 1601             |
| 27667  | 7590        | 08/11/2005           | EXAMINER            |                  |
| HAYES, SOLOWAY P.C.<br>130 W. CUSHING STREET<br>TUCSON, AZ 85701 |             |                      | LAYE, JADE O        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2617                |                  |

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/855,971

Applicant(s)

OMACHI, TAKAO

Examiner

Jade O. Laye

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 2-6, 8-12, 15, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/17/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

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### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 8/17/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### *Claim Objections*

2. Claims 2-6, 8-12, 14, 15, 17, and 18 are objected to because of the following informalities: Each contains the term "Claim," which should not be capitalized within the body of a claim.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wilkins*. (US Pat. No. 5,466,919).

As to claim 1, *Wilkins* discloses a system for transmitting and receiving commercial messages ("CM") and/or advertisements comprising a broadcast station terminal, which

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transmits a plurality of compressed audiovisual signals (i.e., scaled-down and synthesized images/voices). The system also comprises a transmitting device used to modulate said audiovisual signal and a receiving terminal, which automatically selects a commercial message based upon a subscriber's profile. Lastly, the transmitted CM's contain identification information, such as that described at Column 11, Lines 27-38. (Abstract; Col. 2, Ln. 44-53; Col. 8, Ln. 42-61; Col. 9, Ln. 13-19; Col. 6, Ln. 43-67; col. 17, Ln. 14-22; Col. 9, Ln. 32-40; Col. 10, Ln. 1-11; Col. 11, Ln. 27-38). Accordingly, *Wilkins* anticipates each and every limitation of claim 1.

Claim 13 corresponds to the system claim 1. Thus, it is analyzed and rejected as previously discussed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 2, 4-6, 7-12, 14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wilkins* in view of *Wachob*. (US Pat. No. 5,155,591).

Claim 2 recites the system of claim 1, and further limitations too numerous to recite herein (refer to claim sheet). As to claim 2, *Wilkins* discloses all limitations of claim 1, but fails to specifically recite the limitations of claim 2. However, within the same field of endeavor, *Wachob* discloses a similar system wherein the receiving terminal (i.e., set top box) transmits CM/Identification information to the headend (i.e., advertising terminal) in order to provide statistical data. (Abstract; Col. 1, Ln. 39-55; Col. 2, Ln. 43-49; Col. 8, Ln. 17-66; Col. 10, Ln. 27-43). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of applicant's invention to combine the systems of *Wilkins* and *Wachob* in order to provide a system which maintains real-time records of demographic characteristics of subscribers and the programs they watch.

As to claim 4, *Wilkins* further discloses the system is capable of switching between alternate commercials (i.e., cutting) and capable of two-way transmission, thereby allowing communication of certain data back to the headend (i.e., advertiser terminal). (Col. 6, Ln. 37-42; Col. 8, Ln. 4-40; Col. 11, Ln. 27-39). Moreover, the system also inherently expands the transmitted data because it can be compressed before transmission. (as discussed under the rejection of claim 1). If the data is compressed, it must be decompressed (i.e., expanded) before it can be displayed. The remainder of the limitations are either inherent (such as the speaker) or were encompassed within claim 1. Accordingly, the combined systems of *Wilkins* and *Wachob* disclose all limitations of claim 4.

As to claim 5, *Wilkins* further teaches the system can also be controlled via a user's manual input. (Col. 10, Ln. 26-40). The remainder of Claim 5's limitations are encompassed within Claim 1. Accordingly, the combined systems of *Wilkins* and *Wachob* disclose all limitations of claim 5.

Claim 6 is encompassed within the limitations of Claim 2. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 7 are combinations of limitations recited in Claims 1 and 5. Thus, it is analyzed and rejected as discussed therein.

Claim 16 corresponds to claim 7. Thus, it is analyzed and rejected as previously discussed.

The limitations of Claims 8, 9, 10, 11, and 12 correspond to the limitations of Claims 2, 3, 4, 5, and 6, respectively. Thus, each is analyzed and rejected as discussed therein.

The limitations of Claim 14 are combinations of limitations recited in Claims 1, 4 and 6. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 17 are combinations of limitations recited in Claims 1, 4 and 6. Thus, it is analyzed and rejected as discussed therein.

Claim 18 corresponds to claim 3. Thus, it is analyzed and rejected as discussed therein.

5. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wilkins*.

Claim 3 recites the system of claim 1, further comprising limitations too numerous to recite herein. (refer to claim sheet). As to claim 3, *Wilkins* further discloses transmitting digital CM/identification information within the vertical blanking interval ("VBI"). (Col. 2, Ln. 31-40;

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Col. 6, Ln. 49-58; Col. 8, Ln. 43-55). Moreover, in digital transmission, it is inherent to transmit data in packets.

Regarding the limitation addressing analog transmission, the Examiner takes Official Notice that, at the time of Applicant's invention, it was notoriously well-known in the art to utilize analog transmission. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of applicant's invention to modify the system of *Wilkins* to also include analog transmission, thereby enabling the system to be available to a broader range of subscribers.

*[Note: At Col. 6, Ln. 49-58, one could argue that analog transmission is discussed because Wilkins specifically states the system also includes "future digital video systems." Therefore, one could infer the system, in general, is addressing analog transmissions.]*

Claim 15 corresponds to the system claim 3. Thus, it is analyzed and rejected as previously discussed.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. *Dedrick* (US Pat. No. 5,717,923) discloses a system for dynamic customization of electronic information.
- b. *Hite et al* (US Pat. No. 5,774,170) disclose a system for delivering targeted ads to consumers.
- c. *Seidman et al* (US Pat. No. 6,298,482) disclose a system for 2-way digital multimedia broadcast.

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- d. *Maillard et al* (US Pat. No. 6,807,675) disclose a system which selects a viewer's profile.
- e. *Picco et al* (US Pat. No. 6,029,045) disclose a system for inserting local content into programming content.
- f. *Watson* (US Pat. No. 4,625,235) discloses a system for remote control switching of television sources.
- g. *Gerace* (US Pat. No. 5,848,396) discloses a system for determining behavioral profiles of customers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye  
August 3, 2005.

  
CHRIS KELLEY  
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